

REMARKS / ARGUMENTS

By this Amendment, Applicants respond to the Office Action dated March 22, 2004 ("the Office Action"), in which claims 91-139 were rejected. With this Amendment, Applicants have canceled claims 124, 138, 139, amended claims 121-122, 123, and 125-126. Accordingly, claims 91-123 and 125-137 are now pending. Authorization is hereby given to charge any fees (e.g., extension fees) associated with this response to Deposit Account No. 06-0916.

Typographical Errors

Applicants note that the claim set filed in the January 18, 2001 Preliminary Amendment contained two claims numbered "91." Applicants appreciate the Office's correction of this oversight. Applicants will confirm the correct dependency scheme (if different), and regret any confusion that these typographical errors may have caused.

Rejection of Claims 121 and 122 under 35 U.S.C. § 112

Claims 121 and 122 were rejected under 35 U.S.C. 112, second paragraph as lacking antecedent basis for the limitation "a third rule set". With this Amendment, Applicants have amended claim 121 in the manner suggested by the Examiner, and respectfully submit that this rejection has been overcome.

Rejection of Claims 123-126 under 35 U.S.C. § 112

Claims 123-126 were rejected under 35 U.S.C. 112, second paragraph as being incomplete for omitting an essential element. Although Applicants respectfully disagree with the Examiner's rejection of these claims, in order to expedite allowance Applicants have amended claim 123 in the manner suggested by the Examiner, and thus submit that this rejection has been overcome.

Rejection of Claims 123-126 under 35 U.S.C. § 102(e)

The Examiner rejected all of the pending claims under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 5,638,443 A to Stefik ("Stefik"). Applicants respectfully traverse this rejection as set forth below.

With respect to Claim 91, Applicants respectfully submit that, as understood, Stefik does not teach or disclose incorporating a first portion of first protected information from a first secure container into a second secure container, storing identification information at least in part identifying the first portion, the storing being governed at least in part by a control from a first control set associated with the first secure container, and transmitting the identification information to a second site, the transmission being governed at least in part by a control from the first control set. Instead, the cited portions of Stefik appear to disclose charging a fee for usage of parts of a digital work, but there is no indication that the usage entails copying a first portion of protected information from a first secure container to a second secure container, and

that the usage fee information is generated or transmitted in accordance with a control from a control set associated with the first secure container. Claims 92-96, 98-120, and 140 are dependent on claim 91, and are thus allowable for at least the reasons set forth above in connection with claim 91.

Claim 121 has been amended to indicate that the memory means and the telecommunications means both operate at least in part under the control of the first rule set, and is thus allowable for reasons similar to those set forth above in connection with claim 91. Claim 122 is dependent on claim 121, and is thus allowable for at least the same reasons as claim 121.

Similarly, claim 123 has been amended to indicate that the means for storing identification information and the means for communicating the stored information both operate at least in part under the control of the first rule set, as previously recited in dependent claim 124. Accordingly, Applicants respectfully submit that claim 123 is allowable for reasons similar to those set forth above in connection with claim 91.

Claims 125 and 126 are dependent on claim 123, and are thus allowable for at least the same reasons as claim 123.

Claim 127 recites copying or transferring at least a first portion of first protected information from a first secure container to a second secure container, the copying or transferring step being at least in part governed by a first rule from a first rule set associated with the first secure container. Claim 127 further recites storing information at least in part identifying the first portion, in compliance with the first rule, and

communicating at least a portion of the identification information to a remote site, also in compliance with the first rule. Thus, Applicants respectfully submit that claim 127 is allowable for reasons similar to those set forth above in connection with claim 91.

Claims 128-137 are dependent on claim 127, and are thus allowable for at least the same reasons as claim 127.

Claims 138 and 139 have been canceled without prejudice, thus rendering the rejection of these claims moot.

Rejection of Claim 114 under 35 U.S.C. § 103(a)

The Examiner rejected claim 114 under 35 U.S.C. 103(a) as being unpatentable over Stefik, as applied to claim 113, and further in view of PCT Published Appln. No. WO 93/01550A1 to Infologic Software, Inc. ("Griswold"). Applicants respectfully traverse this rejection as set forth below.

As stated above with respect to claim 91 (from which claim 114 ultimately depends), Stefik does not teach or suggest incorporating a first portion of first protected information from a first secure container into a second secure container, storing identification information at least in part identifying the first portion, the storing being governed at least in part by a control from a first control set associated with the first secure container, and transmitting the identification information to a second site, the transmission being governed at least in part by a control from the first control set. Instead, Stefik discloses only charging a fee for usage of parts of a digital work, with no indication that the usage entails copying a first portion of protected information from a

first secure container to a second secure container, and that the usage fee information is generated or transmitted in accordance with a control from a control set associated with the first secure container. Without acquiescing to the correctness of the instant combination of references, Applicants also respectfully submit that Griswold fails to disclose or suggest the same teachings noted above as being absent from Stefik. In addition, this deficiencies is not cured by the combination of Stefik and Griswold argued by the Office. Therefore, Applicants respectfully submit that claim 114 is patentable over Stefik and Griswold, alone or in combination.

Request for Reconsideration/Interview

In setting forth the disagreement with the Office herein, Applicants submit (1) that the scope of Stefik has been extended beyond the teachings contained within the reference and/or the characterizations from previous prosecution history, and (2) that Griswold has also been characterized more favorably than the four corners of the document allow. Applicants respectfully request that the Office review Stefik and Griswold with respect to the deficiencies and missing elements identified above, and reconsider the rejections set forth in the most recent Office action. Further, Applicants hereby request telephonic interview concerning the Office's characterization of Stefik and Griswold, and their application to the pending claims. Please contact the undersigned directly via telephone, at 650-849-6643, to schedule an interview between Applicants, counsel, and representatives from the Office.

Appn. No. 09/764,370
Amdmnt and Response filed September 22, 2004
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Customer No. 22,852
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CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in allowable form, and respectfully request reconsideration of the rejections and the timely allowance of the claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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